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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,449	04/30/2001	Tomio Kondou	64859 CCD	2494
7590 10/06/2004			EXAMINER	
Christopher C. Dunham Cooper & Dunham LLP 1185 Ave. Of the Americas New York, NY 10036			DOE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/845,449	KONDOU ET AL.	
	Examiner	Art Unit	
	Janis L. Dote	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1756

1. The examiner acknowledges the amendments to claims 1, 6, and 25 filed on Jul. 9, 2004. Claims 1-7 and 25 are pending.

2. The rejection of claims 6, 7, and 25 under 35 U.S.C. 112, second paragraph, set forth in the office action mailed on Jan. 30, 2004, paragraph 13, has been withdrawn in response to the amendment to claim 6 filed on Jul. 9, 2004.

3. The pigments "Naphthol Carmine F6B" and "Naphthol Carmine FBB" recited in instant claim 1 are defined by the chemical formulas (4) and (5), respectively, at page 8, lines 1-10, of the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1756

Claim 25 is indefinite in the phrase "the toner further comprises an aromatic hydrocarboxylic acid metal salt . . . ." (emphasis added) for lack of unambiguous antecedent basis in the claim. Claim 25 previous recites the use of a yellow toner, a magenta toner, and a cyan toner image. It is not clear to which toner or toners, e.g., the yellow toner, or the magenta toner, or the cyan toner, or some combination of the toners, the phrase "the toner further comprises" refers.

6. Claim 25 is objected to because of the following informalities:

The phrase "The A method for forming a full color image" (emphasis added) comprises the articles "the" and "a". One of the articles should be deleted.

Appropriate correction is required.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,805,969 (Elsermans) combined with US 6,020,100 (Iwasaki), as evidenced by Chemical Abstracts (CA)

Art Unit: 1756

Registry Numbers 77804-81-0 and 147-14-8, and Industrial Organic Pigments, Table 18 at page 289.

The claims are rejected for the reasons discussed in the office action mailed on Jan. 30, 2004, paragraph 5, which are incorporated herein by reference.

9. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elsermans combined with Iwasaki, as evidenced by Chemical Abstracts (CA) Registry Numbers 77804-81-0 and 147-14-8, and Industrial Organic Pigments, Table 18 at page 289, as applied to claim 1 above, further combined with additional teachings in Iwasaki.

The claims are rejected for the reasons discussed in the office action mailed on Jun. 27, 2003, paragraph 9, which are incorporated herein by reference.

10. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elsermans combined with Iwasaki, as evidenced by Chemical Abstracts (CA) Registry Numbers 77804-81-0 and 147-14-8, and Industrial Organic Pigments, Table 18 at page 289, as applied to claim 1 above, further combined with US 5,554,478 (Kuramoto' 478).

Art Unit: 1756

The claims are rejected for the reasons discussed in the office action mailed on Jun. 27, 2003, paragraph 10, which are incorporated herein by reference.

11. Claims 1, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki, as evidenced by Chemical Abstracts (CA) Registry Numbers 77804-81-0 and 147-14-8, and Industrial Organic Pigments, Table 18 at page 289, combined with US 3,874,892 (McInally) and US 5,521,688 (Moser).

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki, as evidenced by Chemical Abstracts (CA) Registry Numbers 77804-81-0 and 147-14-8, and Industrial Organic Pigments, Table 18 at page 289, combined with McInally and Moser.

The claims are rejected for the reasons discussed in the office action mailed on Jan. 30, 2004, paragraph 8, which are incorporated herein by reference.

12. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki, as evidenced by Chemical Abstracts (CA) Registry Numbers 77804-81-0 and 147-14-8, and Industrial Organic Pigments, Table 18 at page 289, combined with McInally

Art Unit: 1756

and Moser, as applied to claim 1 above, further combined with Kuramoto' 478.

The claims are rejected for the reasons discussed in office action mailed on Jun. 27, 2003, paragraph 12, which are incorporated herein by reference.

13. As discussed in the office action mailed on Jun. 27, 2003, paragraph 13, the rejections set forth in the final rejection mailed on Oct. 2, 2002, paragraphs 9, 11, and 13, are now considered to be cumulative with the rejections over Elsermans combined with Iwasaki, alone or combined with Kuramoto' 478, set forth in paragraphs 8-10 above. For the reasons discussed in the final rejection mailed on Oct. 2, 2002, these rejections would apply equally to the subject matter recited in claims 1-7, but are not set out expressly here.

14. Applicants' arguments filed on Jul. 9, 2004, with respect to the rejections set forth in paragraphs 8-12 above have been fully considered but they are not persuasive.

Applicants assert that "none of the references cited by the examiner as showing non-contact fixing or its advantages even alludes to the problems of inferior image quality heretofore associated therewith - let alone suggests how to overcome those

Art Unit: 1756

problems" as recognized and achieved by applicants. Applicants further assert that the present invention solves the "color balance problem in non-contact fixing by properly combining colorants in the color toners, as well as the order of their positions, as recited in instant claim 1."

However, the reasons for combining the references do not have to be those of applicants. In each of the rejections set forth in paragraphs 8-10 above, the combined teachings of the cited prior art provide ample teaching, suggestion, or motivation for a person having ordinary skill in the art to use the color toners disclosed by Iwasaki or rendered obvious over the combined teachings of Iwasaki and Kuramoto'478 in the method for forming full color image disclosed by Elsermans. In the rejections set forth in paragraphs 11 and 12 above, the teachings of McNally and Moser provide ample teaching, suggestion, or motivation for a person having ordinary skill in the art to use the non-contact fixing method disclosed by Moser in the method disclosed by Iwasaki or rendered obvious over the combined teachings of Iwasaki and Kuramoto'478. Thus, the combination of references cited in paragraphs 8-12 above renders prima facie obvious the instantly claimed invention.

Moreover, for the reasons discussed in the office actions mailed on Jun. 27, 2003, paragraph 14, items (1) and (3), and on



Art Unit: 1756

Jan. 30, 2004, paragraph 11, items (1) and (2), the showing in the instant specification is insufficient to show that the instantly claimed invention yields unexpected results over the prior art. The discussions in the office action mailed on Jun. 27, 2003, paragraph 14, items (1) and (3), and in the office action mailed on Jan. 30, 2004, paragraph 11, items (1) and (2), are incorporated herein by reference.

Accordingly, for the reasons discussed above and in the rejections set forth in paragraphs 8-12, the rejections of claims 1-7 over the cited prior art stand.

15. Claims 1-7 and 25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22, 24, and 26-45 of copending Application No. 10/302,898 (Application'898) in view of Elsermans.

The claims are rejected for the reasons set forth in the office action mailed on Jan. 30, 2004, paragraph 15, which are incorporated herein by reference.

Applicant's arguments filed on Jul. 9, 2004, have been fully considered but they are not persuasive.

Applicants states that "[s]ince no patent has yet issued on application No. 10/302,898, it is believed unnecessary to respond to the rejection at this time."

Applicants' statement is not responsive to the rejection. Accordingly, the rejection stands.

16. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to

Art Unit: 1756

Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD

Oct. 4, 2004

*Janis L. Dote*  
JANIS L. DOTE  
PRIMARY EXAMINER  
GROUP 1800  
1700